

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :
Lars BURGDORF et al. : Group Art Unit.: 1617
Serial No.: 10/590,724 : Examiner: ZAREK, Paul E.
Filed: August 25, 2006 :
Title: PYRIDINAMIDE DERIVATIVES AS KINASE INHIBITORS

REPLY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed on November 5, 2008, applicants elect with traverse Group I, claims 1-10, drawn to compounds as identified in the Office Action.

The traversal is on the basis that the PTO has not established that it would pose an undue burden to examine the full scope of the application.

As to the Election of Species Requirement, applicants elect, again with traverse for the same reason as above, compound number 16 in the application, i.e., N-methyl-4-[3-(2-methoxy-5-trifluoromethylphenylcarbamoyl)phenoxy]pyridine-2-carboxamide (tosylate), the structure of which is depicted on page 53 of the application along with data on said compound.

In accordance with M.P.E.P. 803.02, the Examiner is reminded that, should no prior art be found which renders the invention of the elected species unpatentable, the search of the remainder of the generic claim(s) should be continued in the same application. Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. See MPEP 803.02 in accord.

In this regard applicants provide as guidance for the direction of the search, the compounds of formula I, where Ar¹ is phenyl mono or di-substituted by CF₃ and/or OCH₃; Ar² is phenyl; Ar³ is pyridyl substituted by CONHCH₃; Y is O, and Z is O. As the search progresses, applicants request that compounds within this scope be searched before compounds outside of this designated scope.

Additionally, applicants bring the attention of the Examiner to MPEP § 821.04, Rejoinder, which states that "if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims [both process of making and using] which either depend from or include all the limitations of the allowable product will be rejoined." If the restriction requirement is maintained at this point, rejoinder of the non-elected method/process (use) claims is respectfully requested at the proper time in accord with the rejoinder provisions of the MPEP.

No fee is believed to be due with this response; however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Csaba Henter/

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Attorney Docket No.: MERCK-3229

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